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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,995	08/31/2001	Kazuyoshi Tokunaga	H07-137077M/STS	9298
21254	7590	03/07/2006	EXAMINER	
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC			MURPHY, DILLON J	
8321 OLD COURTHOUSE ROAD			ART UNIT	
SUITE 200			PAPER NUMBER	
VIENNA, VA 22182-3817			2624	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/942,995

Applicant(s)

TOKUNAGA ET AL.

Examiner

Dillon J. Murphy

Art Unit

2624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 2/23/2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-22.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER

Continuation of 13. Other:

Regarding claim 1, applicant argues that Gasper and Zhang are not combinable, with Gasper teaching away from Zhang (Remarks, page 17, ln 1-9). The examiner respectfully disagrees, citing Gasper in col 3, ln 51-62, wherein the advantages and objective of the invention of Gasper is to provide an image that encodes information in a document that is invisible to a human but detectable by a machine, without degrading the quality of the document. The examiner also cites Zhang, in col 3, ln 25-32, wherein Zhang provides a system and method for encoding information in a non-intrusive manner, i.e. not detectable by an observer, within a document. Both inventions are related to invisible information recording, and both Zhang and Gaper are motivated to encode information readable by only a machine without degrading the quality of the printed matter on the document.

Regarding claim 13, applicant argues on page 8, lines 1-10, that Zhang teaches encoding a print control symbol at only one predetermined location. The examiner respectfully directs the applicant to col 4, lines 53-60 of Zhang wherein print control symbols are printed at predetermined positions (i.e. a plurality of positions) separate from the informational content of the printed matter. Also see col 3, lines 50-63, wherein Zhang explicitly states that the invisible image is printed separate from any informational content on the document, i.e. the invisible image is recorded on blank locations in the document.

Regarding claims 16 and 17, rejected under 35 U.S.C. 103a over Boswell, Zhang, Gasper, and Ur, applicant argues, on pages 22-24, that Ur does not teach extracting a plurality of blank areas. The examiner applies a similar reasoning as explained above in claim 13, wherein Zhang extracts a plurality of blank locations for the purpose of recording information in said blank locations.